

REMARKS

Claims 1-78 were originally presented in the subject application. Claim 73 has hereinabove been amended to more particularly point out and distinctly claim the subject invention. No claims have herein been added or canceled. Claims 1-72, 74 and 75 have been withdrawn as directed to non-elected inventions. Therefore, claims 1-81 remain in this case, with only claims 73 and 76-81 being actively examined.

/ The addition of new matter has been scrupulously avoided. In that regard, support for the amendment to claim 1 can be found in the specification at, for example, FIGs. 13-16 and the description thereof at numbered paragraph 0018.

Applicant respectfully requests reconsideration and withdrawal of the various grounds of rejection.

Restriction Requirement

The final Office Action maintained the restriction requirement under 35 U.S.C. §121. The claims of the application were restricted to Group I (claims 1-53), Group II (claims 54-72), and Group III (claims 73-78). Further, the Group III claims were restricted to species A (claims 73, 74, 77 and 78), B (claims 73, 75, 77 and 78) and C (claims 73 and 76-78).

Applicants previously elected the claims of Group III, species C, i.e., claims 73 and 76-78. However, as noted in the prior Office Action, claim 73 is currently a generic claim. If allowed, Applicant will have the right to bring claims 74 and 75 (i.e., species A and B) back into active prosecution.

35 U.S.C. §102 Rejection

The Office Action rejected claims 73 and 77-81 under 35 U.S.C. §102(b or e), as allegedly anticipated by Tanahashi et al. (U.S. Patent Application Publication No. 2004/0234428 A1). Applicant respectfully, but most strenuously, traverses this rejection.

Tanahashi et al., being a U.S. Patent Application Publication, has an effective date for purposes of §102(b) of its U.S. publication date, namely November 25, 2004. Since that date is after the filing date of the present application, Applicant submits that Tanahashi et al. cannot properly be cited against the present application under §102(b).

The effective filing date of Tanahashi et al. for purposes of §102(e) is the §371(c) date (i.e., proper national entry into U.S. from PCT), because the PCT counterpart of Tanahashi et al. was published in Japanese. See MPEP §2136.03. The §371 (c) date is given as January 26, 2004 in the PAIR system.

As shown in the attached Rule 131 Declaration of Walter J. Smith (Smith Declaration), Mr. Smith conceived of the claimed n-point star where n is at least 3, prior to the effective date of Tanahashi et al., i.e., prior to January 26, 2004.

As set forth in the Smith Declaration and corroborated by the attached Rule 131 Declaration of Wayne F. Reinke (Reinke Declaration), handwritten notes to a draft patent application in the parent case were provided from Mr. Smith to Mr. Reinke on August 17, 2000. Among the notes is a page of graph paper referencing pages 13, 16 and 4 of the draft application, and including sketches of various cross-sectional shapes for the filaments of the invention. The sketches include a three-point star shape, a four-point star shape, and a five-point star shape, each of which conforms to the definition of “n-point star” given in the present application at numbered paragraph 0039 (see Exhibit A to the Smith Declaration). Although there is no date on the handwritten comments, notes and sketches, it is clear from a comparison with the parent application, and considering the Declarations, that the comments were created between the date the draft application was sent to Mr. Smith (i.e., May 30, 2000), and the date of the office conference to discuss the same (i.e., August 17, 2000). Moreover, it is clear that the comments were created prior to the filing of the parent application, October 25, 2001. Both dates, that of the office conference and the filing date of the parent application, necessarily took place years prior to the §102(e) effective date of Tanahashi, i.e., January 26, 2004.

In addition, the Smith Declaration shows due diligence from prior to the effective date of Tanahashi et al. to the filing of the present application. The present application was filed on

March 19, 2004 according to the records of the U.S. Patent and Trademark Office and the attached Rule 131 Declaration of Wayne F. Reinke (Reinke Declaration, paragraph 7). The effective date of Tanahashi et al. was during the statutory time limit to respond to the final Office Action in the parent case. The present application was filed within that statutory time limit. Thus, Applicant submits this shows diligence from prior to the effective date of Tanahashi et al. to the filing of the present application.

Therefore, Applicant submits that Tanahashi et al. has effectively been sworn behind by the evidence presented.

The Office Action also rejected claims 73 and 77-81 under 35 U.S.C. §102(b) as allegedly anticipated by Dobo et al. (U.S. Patent No. 4,175,153). Applicant respectfully, but most strenuously, also traverses this rejection.

With respect to the anticipation rejection, it is well settled that a claimed invention is not anticipated unless a single prior art reference discloses: (1) all the same elements of the claimed invention; (2) found in the same situation as the claimed invention; (3) united in the same way as the claimed invention; (4) in order to perform the identical function of the claimed invention. In this instance, Dobo et al. fails to disclose at least one element of claim 73 and as a result does not anticipate, or even render obvious, Applicant's invention.

Amended claim 73 recites, for example, that the flexible filament is solid.

It is clear from the specification of Dobo et al. (e.g., see the title, "Inorganic Anisotropic Hollow Fibers") that the fibers therein are hollow. Moreover, Applicant submits that a solid filament would not allow for the purpose of Dobo et al., i.e., gas/liquid separation. Thus, Applicant submits Dobo et al. cannot disclose, teach or suggest a solid flexible filament.

Therefore, Applicant submits that claim 73 cannot be anticipated by, or made obvious over, Dobo et al.

35 U.S.C. §103 Rejection

The Office Action rejected claim 76 under 35 U.S.C. §103, as being obvious over Tanahashi et al. (U.S. Patent Application Publication No. 2004/0234428 A1) (based on §102(e)), and in further view of any of JP 2000045174 A, JP 352148219 A, and JP 60162868 A. Applicant respectfully, but most strenuously, traverses this rejection.

Claim 76 recites that at least one arm of the n-pointed star is radiused.

The final Office Action alleges that the cited Japanese references show it is old in the art to form star-shaped fibers with arcuate point portions. However, Applicant does not acquiesce to the allegation, in light of the §131 declarations and dates therein. In addition, none of the shapes in FIG. 9 of Tanahashi et al. qualifies as the claimed n-point star, where n is at least 3. Note that “n-point star” is defined in the present application at numbered paragraph 0039, with specific examples described in the paragraphs following and referencing the drawings.

Moreover, in order to qualify as a proper reference under §103, Applicant submits that Tanahashi et al. must first qualify as a reference under §102. However, as noted above with respect to the §102 rejection, Tanahashi et al. has been sworn behind.

Therefore, Applicant submits that claim 76 cannot be rendered obvious over Tanahashi et al.

CONCLUSION

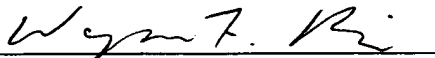
Applicant submits that the dependent claims not specifically addressed herein are allowable for the same reasons as the independent claim from which they directly or ultimately depend, as well as for their additional limitations.

Applicant acknowledges the references cited in the Office Action, but not substantively applied. However, Applicant submits that the pending claims are patentable thereover as well.

For all the above reasons, Applicant maintains that the claims of the subject application define patentable subject matter and earnestly requests allowance of claims 73 and 76-81, as well as reinstatement of claims 74 and 75.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicant's undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,


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